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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,400	05/07/2001	Ai J. Lin	P66823US0(WRAIR-01)	9445

7590 12/23/2003

Office of the Staff Judge Advocate
U.S. Army Medical Research and Materiel Command
ATTN: MCMR-JA (Ms. Elizabeth Arwine)
504 Scott Street
Fort Detrick, MD 21702-5012

EXAMINER

PATEL, SUDHAKER B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/849,400	Applicant(s) LIN ET AL.	
	Examiner Sudhaker B. Patel, D.Sc.Tech.	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32,33 and 49-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 and 33 is/are rejected.
- 7) ☒ Claim(s) 49-57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' communication paper dated 11/12/03 is acknowledged.

After further review and reconsideration, this application is not yet ready for allowance for the reasons stated below.

Together with their earlier communication(s), applicants have cancelled claims 1-31,34-48, amended claims 33, 49, 51, 52, 53,54, and recited new claims55-57. Therefore, the claims under consideration are the claims 32,33,49-57.

1. Rejections maintained: Rejections for compound Claim 32 and its composition claim 33 made under 35 U.S.C. 103(a) as per earlier office action paper dated6/13/03 are maintained further for the reasons already stated therein. Applicants argued that the instant compound has a different use than the uses taught by prior art of record ref. '414. However, as already recited in earlier communication, Claiming a new compound having one additional -CH₂- group in a bridge of prior art propyl bridge, and its new use, new function or unknown property which is inherently present in the prior art does not necessarily make the compound claim patentable. In re Best, 562 F. 2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP 2141.02. Prior art reference teaches making of compounds with a propyl bridge, and it also teaches that the compounds have pharmacological properties, and are histamine antagonists and antispasmodic agents.

Applicants have not provided any data to support their invention of compounds having improved utility for a bridge butyl over Propyl Bridge of the ref.'414.

New rejections/objections:

2. Claims 54, 57 are objected to because of the following informalities: Claims 54,57 objected to under 37 CFR 1.75 as being a substantial duplicate of claim 49 & 33 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 52 should be recited as: "The pharmaceutical composition comprising of ingredients of claim 57, and further an additional antimalarial".

Appropriate correction(s) to claims, as well corrections to their dependencies are required.

Conclusion

3. Claims 49-51, 52-57 which are related as compositions and their method of use as chemosensitizing agents are objected to as being dependent upon a rejected/objected base compound and its pharmaceutical composition claims 32, 33 respectively, but would be allowable if rewritten in the proper form including all of the limitations of the base claim and any intervening claims.

Therefore, the compositions and method of use claims would be considered for allowance as the references disclosing the homologous compounds do not teach chemisensitizing activity as recited herein.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel, D.Sc. Tech. whose telephone number is (703) 308 4709.

The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah can be reached at (703) 308 4716 or Sr. Examiner Mr. Richard Raymond at 703 308 4523.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

S.p.

December 17, 2003.


Mukund Shah

SUPERVISORY PATENT EXAMINER

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